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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
81230.521US

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on March 21, 2006

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Application Number
09/613,322

Filed
07/11/2000

First Named Inventor
Craig M. Janik

Art Unit
2116

Examiner
Chang, Eric

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 35,906

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Gary R. Jarosik
Signature

Gary R. Jarosik
Typed or printed name

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Telephone number

March 21, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REASONS FOR PRE-APPEAL REVIEW REQUEST

In the application claims 48-67 remain pending and stand finally rejected as being rendered obvious primarily based upon Herold (U.S. Patent No. 5,832,067) as modified by Nishizawa (U.S. Patent No. 6,842,779).

As concerns the rejection of the claims, it is first respectfully submitted that it is believed that Nishizawa is not “prior art” and, for this reason, the rejection of the claims should be withdrawn. More particularly, while the subject application for patent was filed on July 11, 2000, the subject application for patent claims the benefit of provisional application numbers 60/143,475, 60/158,986, and 60/166,052 filed on July 12, 1999, October 12, 1999, and November 17, 1999, respectively.

Considering now Nishizawa, Nishizawa issued as a patent on January 11, 2005 from an international application for patent that was filed prior to November 29, 2000 and, as such, it is believed that the 35 U.S.C. § 102(e) date for Nishizawa cannot be earlier than the date of fulfillment of the requirements of 35 U.S.C. § 371(c)(1), (2) and (4), i.e., November 12, 1999. (See MPEP 706.02(f)(1)). Since the filing date of at least two of the provisional applications for patent to which the subject application for patent claims priority predate the earliest filing date to which Nishizawa may be entitled, it is respectfully submitted that the rejection under 35 U.S.C. § 103 should be withdrawn.

Notwithstanding the foregoing, it is respectfully submitted that the combination of Herold and Nishizawa still fails to disclose each and every element set forth in the claims as is required to maintain a *prima facie* case of obviousness. In this regard, Herold discloses a method and an apparatus for transferring information from a remote server to an alarm clock. Specifically, the alarm clock has a selectable switch indicative of a plurality of states and the remote server stores a plurality of messages. At a designated time, the alarm clock generates an alarm signal which is

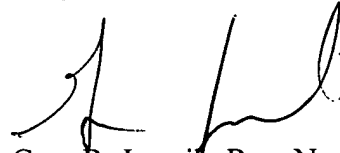
used to dial the remote server and the remote server selects a message to return to the alarm clock, the message being selected based upon the state of the selectable switch. Accordingly, it will be appreciated that the system of Herold does not function by providing a content preference selection to a server for use in connection with a search engine which functions to retrieve from the Internet content that is relevant to the content preference selection for return to the alarm clock as is claimed. That Herold fails to disclose at least these claimed elements has been acknowledged in the rejection of the claims.

Considering now Nishizawa, Nishizawa discloses an agent accessory tool that operates external to a web browser and which, at a designated time, checks for new data or information at a web application and displays a message in order to inform the user that the web application possesses new data or information which the user may then desire to access. (Col. 2, lines 27-40). By way of example, Nishizawa describes that the user may be informed of the arrival of new mail at a web mail application through the emission of a sound or movement on a screen without the user being required to first open or activate a browser. (Col. 4, lines 45-56). While Nishizawa discloses signaling a user that information is available at a Web application without requiring the user to first open or activate a browser, it will be appreciated that Nishizawa does not disclose, teach, or suggest that which is missing from Herold, namely, providing a content preference selection to a server for use in connection with a search engine which functions to retrieve from the Internet content that is relevant to the content preference selection let alone for return to any type of play back device, such as an alarm clock, as is set forth in the claims. Thus, by failing to disclose, teach, or suggest those claimed elements that are missing from Herold, it is respectfully submitted that nothing from within Nishizawa can be said to suggest modifying Herold to arrive at the invention that is set forth in the claims. For at least this further reason it is

respectfully submitted that the rejection of the claims fails to present a *prima facie* case of obviousness and must be withdrawn.

In view of the foregoing it is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the reviewing panel is respectfully requested.

Respectfully Submitted;

A handwritten signature in black ink, appearing to read 'G. Jarosik', written over a horizontal line.

Date: March 21, 2006

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